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## REMARKS

This Response, filed within two months of the mailing date of the May 30, 2002 final Office Action, is intended to provoke an Advisory Action from the Patent Office. Applicants believe that, based on the allowed and objected to claims of the final Office Action, the application as amended herein is in condition for allowance. Prior to this Response, Claims 1 to 10, 12, 13, 15, 17, 19-23 and 25 to 36 were pending. The Patent Office allowed Claims 17, 19 to 23 and 27 to 30. Claims 1 to 5, 7 to 10, 15, 25, 26 and 31 to 36 were rejected. Claims 6, 12 and 13 were objected to.

In this reply, Claims 1, 4, 12, 15, 17, 31, 34 and 35 are being amended. Claims 5, 6, 8, 33 and 36 are being cancelled without prejudice or disclaimer. No new matter is being introduced via the amendments. Applicants do not believe any fee is owed in connection with this Response. Nevertheless, please charge Deposit Account No. 02-1818 for any fees owed.

In the final Office Action, Claim 35 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for lacking sufficient antecedent basis for "the other non-wild symbols". Claims 1, 2, 4, 5, 9, 10, 15, and 31 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,299,165 to Nagano ("*Nagano*"). Claims 3, 7, 8, 33 and 36 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Nagano* and U.S. Patent No. 6,089,977 to Bennett.

Claim 35 is being amended herein to remove the words "of the" in front of "other non-wild symbols". Applicants believe that this amendment overcomes the rejection under § 112, second paragraph, and that amended Claim 35 is therefore in condition for allowance.

Claim 1 is being amended herein to include the limitations of objected to Claim 6, namely, generating "on a plurality of paylines" a set of symbols. The preamble also now recites "a slot machine". Because the limitations of objected to Claim 6 have been added, Applicants respectfully submit that this claim, as well as Claims 2 to 4, 7, 9, 10, 12, 13 and 15 that directly or indirectly depend from Claim 1 are in condition for allowance. Applicants maintain that this amendment is being made to further prosecution, that the amendment to Claim 1 is not an admission that the amendment is necessary to overcome the art of record, and that Applicants expressly reserve the right

to seek other patent protection on the subject matter of the present application in a continuation application. Moreover, the amendments to Claims 4, 12 and 15 and the cancellation of Claims 5, 6 and 8 are being made solely for the purpose of eliminating inconsistent language between the dependent claims and Claim 1 as amended herein, and not for any substantive reason of patentability under 35 U.S.C. §§ 100, 102 or 103.

Allowed Claim 17 is being amended solely to clarify an error in grammar.

Claims 31 and 34 are also being amended to recite "a slot machine" in the preamble and to include randomly generating on a plurality of paylines, a set of symbols. Because Claims 31 and 34 as amended include the limitations of objected to Claim 6, Applicants believe that these claims are in condition for allowance. Claim 34 has also been amended in a number of places solely for the purposes of clarity and readability.

Independent Claim 32 was not rejected or allowed in the final Office Action. Based on the allowed and objected to Claims in the Office Action, however, Applicants believe that this claim is allowable at this time. Applicants believe that Claim 32 is allowable for the same reasons that Claim 17 has been allowed.


Attached hereto is a marked-up version of the changes made to the specification and Claims by the current amendment. The attached page is captioned "**Versions with Markings to Show Changes Made.**"

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Claim 1 has been amended as follows:

1. (Twice Amended) A method for operating a ~~gaming device~~ slot machine including a plurality of symbols, said method comprising the steps of:

- (a) maintaining a list of award-yielding symbol combinations of said plurality of symbols in a controller;
- (b) randomly generating on a plurality of paylines a first set of the symbols from the plurality of symbols;
- (c) providing an award for each award-yielding symbol combination appearing in said first set;
- (d) selecting at least one but not all of the symbols in the first set for individual replacement and individually replacing each said selected symbol in the first set with one of the plurality of symbols to generate a second set of the symbols; and
- (e) providing an award for each award-yielding symbol combination appearing in said second set regardless of whether said award yielding symbol combination in the second set appeared in the first set.

Claim 4 has been amended as follows:

4. (Twice Amended) The method of Claim 1, wherein ~~the gaming device is a slot machine having a plurality of reels, the symbols are on said plurality of reels and the step of individually replacing the symbols includes individually replacing the selected symbols without spinning the reels.~~

Claims 5, 6 and 8 have been cancelled without prejudice or disclaimer.

Claim 12 has been amended as follows:

12. (Twice Amended) The method of Claim 1, wherein ~~the gaming device is a slot machine including a plurality of reels having said symbols on said reels, wherein when the first set includes a wild symbol,~~ the step of replacing each selected symbol includes individually replacing one of the other symbols on the a plurality of reels, wherein said wild symbol functions as one of the plurality of symbols.

Claim 15 has been amended as follows:

15. (Twice Amended) The method of Claim 1, wherein ~~the gaming device is a slot machine including a plurality of reels having said symbols on the reels, and wherein when the first set of symbols includes a wild symbol,~~ the step of replacing each selected symbol in the first set includes substituting a wild symbol for at least one other of the symbols in a row of symbols ~~of the~~ along a plurality of reels of the slot machine, wherein said wild symbol functions as one of the plurality of symbols.

Claim 17 has been amended as follows:

17. (Twice Amended) A method for operating a gaming device including a plurality of symbols, said method comprising the steps of:

(a) maintaining in a controller of said gaming device a list of award yielding symbol combinations of said plurality of symbols;

(b) generating a set of said symbols, wherein one of said symbols in said set is a first wild symbol;

(c) providing an award for each award yielding symbol combination appearing in said set including the generated wild symbol which functions as one of the other symbols to maximize the award yielding combinations;

(d) selecting at least one but not all of the symbols in the set except for the first wild symbol in the set for individual replacement and individually replacing each said selected symbol with a second wild symbol; and

(e) providing an award for each award yielding symbol combination appearing in said set, including the wild symbols which replace other symbols and ~~functions~~ function as one of the symbols to maximize the award yielding symbol combinations.

Claim 31 has been amended as follows:

31. (Twice Amended) A method for determining an award in a ~~gaming device~~ slot machine including a plurality of symbols and a plurality of award yielding combinations of said symbols, said method comprising the steps of:

- (a) randomly generating on a plurality of paylines a first set of said symbols;
- (b) providing a player an award for each award yielding symbol combination appearing in said first set;
- (c) ~~selecting at least one but not all of the symbols in said first set for~~ individual replacement and individually replacing each said selected symbol with one of the symbols; and
- (d) providing an award for each award yielding symbol combination appearing in said second set including all award yielding symbol combinations in the second set regardless of whether an award was provided for such award yielding combinations in the first set.

Claim 33 has been cancelled without prejudice or disclaimer.

Claim 34 has been amended as follows:

34. (Amended) A ~~gaming device~~ slot machine comprising:

- a plurality of reels and a plurality of paylines associated with the reels;
- a plurality of symbols on said reels, said symbols including ~~at least one~~ a wild symbol;
- a plurality of symbol combinations that each yield an award if generated by said reels; and
- a processor which controls said reels, wherein said processor: (i) causes the reels to generate a set of said symbols and ~~wherein when one of said symbols in said set is one of the wild symbols, said processor~~ along the paylines; (ii) provides an award for each award yielding symbol combination in said set, wherein said wild symbol functions as at least one other non-wild symbol, ~~and then individually~~; (iii) substitutes

another ~~wild symbol~~ for one of the non-wild symbols in said set ~~except for said wild symbol~~, with another wild symbol; and (iv) provides an award for each award yielding symbol combination in said set, regardless of whether the combination includes a wild symbol, ~~and~~ wherein each wild symbol functions as at least one other non-wild symbol.

Claim 35 has been amended as follows:

35. (Amended) ~~The~~ A gaming device comprising:

a processor;

a memory device which maintains a plurality of symbols and a plurality of award yielding symbol combinations, wherein the processor communicates with the memory device to:

generate a set of symbols, wherein one of said symbols is a wild symbol;

provide an award for each symbol combination appearing in said set, wherein said wild symbol functions as one of the symbols;

individually substitute another wild symbol for at least one but not all of the other non-wild symbols in said set; and

provide an award for each symbol combination appearing in said set, wherein each wild symbol functions as one of the symbols.

Claim 36 has been cancelled without prejudice or disclaimer.